

**REMARKS**

The Official Action mailed January 12, 2006, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Also, filed concurrently herewith is a *Request for Continued Examination*. Accordingly, the Applicants respectfully submit that this response is being timely filed.

The Applicants note with appreciation the consideration of the Information Disclosure Statements filed on October 29, 2003; March 1, 2004; and June 23, 2005. A further Information Disclosure Statement was submitted on January 5, 2006, and consideration of this Information Disclosure Statement is respectfully requested.

Claims 6-38 are pending in the present application, of which claims 6-8 and 27 are independent. Independent claims 6-8 and 27 and dependent claims 35-38 have been amended to better recite the features of the present invention. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 2 of the Official Action rejects claims 6-38 as anticipated by U.S. Patent Application Publication No. 2003/0032210 to Takayama et al. The Applicants respectfully submit that an anticipation rejection cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Independent claims 6 and 8 have been amended to recite forming a metal layer in contact with a substrate and removing a portion of the metal layer which is in contact with a peripheral portion of the substrate, which is supported in the specification, for example, at page 7, lines 1-4, and at page 12, lines 19-21. Similarly, independent claims 7 and 27 have been amended to recite removing a portion of a metal layer

formed over a peripheral portion of the substrate, which is supported in the specification, for example, page 12, lines 19-24. The Applicants respectfully submit that Takayama '210 does not teach the above-referenced features of the present invention, either explicitly or inherently.


Since Takayama '210 does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

The Official Action provisionally rejects claims 6-34 under the doctrine of obviousness-type double patenting over the combination of claim 17 of copending Application Serial No. 10/193,912 to Takayama et al. (Takayama '210 is the publication of the '912 application) and U.S. Patent No. 6,372,603 to Shimoda et al.

The Applicants respectfully traverse the obviousness-type double patenting rejection. As noted above, independent claims 6 and 8 have been amended to recite forming a metal layer in contact with a substrate and removing a portion of the metal layer which is in contact with a peripheral portion of the substrate, and independent claims 7 and 27 have been amended to recite removing a portion of a metal layer formed over a peripheral portion of the substrate. The claims of Takayama '912 and Shimoda do not teach or suggest the above-referenced features of the present independent claims. It is respectfully submitted that the claims of the present application are not a timewise extension of the invention as claimed in Takayama '912, either alone or in combination with Shimoda. Reconsideration and withdrawal of the obviousness-type double patenting rejections are requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

  
\_\_\_\_\_  
Eric J. Robinson  
Reg. No. 38,285

Robinson Intellectual Property Law Office, P.C.  
PMB 955  
21010 Southbank Street  
Potomac Falls, Virginia 20165  
(571) 434-6789